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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/832,747 | 04/11/2001 | Virgil Thomas Yancy | TOM995/99795A | 4509 |
| 7590 | 01/13/2004 | | EXAMINER | |
| Mark G. Kachigian Head, Johnson & Kachigian 228 West 17th Place Tulsa, OK 74119 | | | NGUYEN, SANG H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2877 | |

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

| BEST AVAILABLE COPY | | Application No. | Applicant(s) |
|------------------------------|--|-----------------|----------------------|
| | | 09/832,747 | YANCY, VIRGIL THOMAS |
| <i>Office Action Summary</i> | | Examiner | Art Unit |
| Sang H Nguyen | | | 2877 |

.. The MAILING DATE of this communication appears on the cover sheet with the correspondence address ..

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 day MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

Disposition of Claims

4) Claim(s) 14-17, 20 and 21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 14-17 and 20-21 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
a) All b) Some c) None of:
1. Certified copies of the priority documents have been received;
2. Certified copies of the priority documents have been received in Application No. ____;
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other: _____

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DETAILED ACTION

Election/Restriction

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 14-17 and 21, drawn to a first computer program embodied on a computer readable medium which adapts a client general purpose computer for determining and transmitting optical lens sizing and prescription data comprising a code segment for retrieving and deriving a stored image of a represented optical lens object, a code segment for deriving a starting radian of the optical lens object, a code segment for centering a retrieved stored image, a code segment for deriving the radial shape of the optical lens object and deriving the size of the derived radial shape of the optical lens object; a code segment for smoothing the derived radial shape, a code segment for identifying and retrieving patient related information from scanned image, and a code segment for transmitting the derived optical lens object radial shape, size, center, and patent related information from a client central processing unit to a server central processing unit, classified in class 434, subclass 262.
 - II. Claim 20, drawn to a second computer program embodied on a computer readable medium which adapts a server general purpose computer to communicate with a

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client general purpose computer in response to the client computer's transmission of optical lens sizing and prescription data, classified in class 351, subclass 205.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 14 does not recite the details of the claim 21 and the limitations recited in the invention I has not been recited in the other inventions II and vice versa. The subcombination has separate utility such as laparoscopic surgical medical devices.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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6. A telephone call was made to Mr. Mark G. Kachigian, Registration No. 32,840 on 01/08/2004 to request an oral election to the above restriction requirement, but did not result in an election being made

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Sang Nguyen whose telephone number is (703) 308-6426.

Nguyen/SN

SN

January 10, 2004

Frank G. Font

Frank G. Font
Supervisory Patent Examiner
Technology Center 2800